IN THE HIGH COURT OF JUDICATURE AT BOMBAY

O.O.C.J.

MISC. PETITION NO. 8 OF 1996

Harish Chhabra ......Petitioners

vs.

Bajaj Electricals Ltd

and Anr. .....Respondents

Mili Thakkar with H.J. Engineer, Avani Shah
i/b. Gordhandas and Fozdar for the
petitioners.

Ravi Kadam a/w. Manish Saurashtri
i/b. Shantilal and Co. for the respondents.

CORAM: S.U. KAMDAR, J.

DATE : 24TH JUNE, 2005.

JUDGMENT :

1. The present petition has been filed

interalia seeking relief that the design registered by the respondent no.1 being design no. 163381 dated 5.7.1991 in class-1 be cancelled and the second respondent should be directed to expunged and or remove the entry of the said registration from the register of designs. Some of the material facts are as under :

2. The petitioner before this court is claiming to be carrying on business in manufacturing ceiling fans of various designs in the name and style of Siri Ram and Sons. The petitioner is claiming that he was carrying on the aforesaid business for many years and he is also claiming to be the registered sole proprietor of various designs of electrical fans including the design inrespect of the dome (the central motor body) of ceiling fan together with canopy registered under No.167584 in class 1. The respondent no.1 is also a manufacturer of ceiling fans and the claiming to be an inventor of a design of a part of the ceiling fans being

decorative ring on the central part of the ceiling fan. However, the registration of the said design claimed by the respondent no.1 and consequently granted by the second respondent is not inrespect of any part invented by the first respondent but is inrespect of the ceiling fan as a whole.

3. It is the case of the petitioner that in 1994 he conceived a new and original design for the central motor body hub part of ceiling fan known as dome with a canopy in respect of ceiling fan. It is his case that when he made an application for registration under class 1 under the Design Act, 1911 the office of the second respondent registered the said design under number no. 167584 dated 2/6/1984 in class 1.

4. Sometime in or about March 1994 the petitioner received a letter dated 24.3.1995 calling upon the petitioner to cease and resist from manufacturing and marketing fans similar to

the said registered design on the ground that the petitioners fans with the said design is colourable imitation of the first respondent design of a ceiling fan bearing registration design NO. 163381 dated 5.7.1981. The petitioner replied to the said notice by their advocate's letter dated 11.4.1985 and informed the respondent no.1's attorney that the petitioner is the registered proprietor of the said design under class 1. It is the case of the petitioner that the design which was registered by him was conceived and invented by him. The petitioner states that thereafter the respondent no.1 filed a suit in this court being Suit No. 3905 of 1995 on the basis of infringement of the registered design and passing off against the petitioner and claimed that the petitioner should be restrained from acting upon the said design. The petitioner has thereafter filed the present petition under s.51A of the Design Act, 1911 sometime in or about 1996 challenging the design of the respondent no.1 registered by respondent no.2.

5. The essential grounds on which the said relief is sought by the petitioner firstly is that the respondent no.1 has not invented any a new design and/or any new item but has purpotedly sought to register the whole of the ceiling fan as an invented design which is not permissible in law as a ceiling fan is not an invention or a new design for the first time prepared by the respondent no.1. It has been also contended that the registration certificate issued by the respondent no.2 indicates the whole of the ceiling fan in the photograph as a registered design and does not indicate any part or a special features which is separately and independently registered as an invention of such a new design. It has been thus contended that under the provisions of s. 51A of the Design Act the present registration is required to be cancelled and/or registered entry is required to be expunged from the record. On the other hand the learned counsel appearing for the respondent contended that what is invented design is an

ornamental ring fitted on a fan and therefore a fan with such a feature is a design registered by the respondent no.1 and therefore the design is rightly registered. However the learned advocate General appearing on behalf of the respondent no.1 has fairly drawn my attention to the judgment of the House of Lords in the case of **William J. Holdsworth and Ors vs. Henry C. M'crea reported in 1987 Vol.II English and Irish Appeal page 380** wherein it has been held as under :

> ." The only thing which it is here necessary to point out, as well for warning to inventors as for the protection of the public, is this, that if a design, as exhibited in a pattern is filed and registered by an inventor, without any farther limitation or description than that which is given by the design itself, it protects the entire thing and the entire thing only, and the protection

> cannot, at pleasure, be made applicable one day to the entirety and another day to the separate integral parts or elements of the entire design. It must be considered that the protection of the statute is invoked for the entire thing that appears upon the register and is applicable to nothing but the exact copy of the thing so registered."

6. In the light of the aforesaid judgement, the learned counsel has fairly conceeded that the fan as a whole could not have been registered by respondent no.2 and the certificate of registration issued is not inrespect of any part or an separate innovated design but is inrespect of the whole of the ceiling fan since the ceiling fan is not the invention or a new design by the first respondent, the same could not have been

registered by the second respondent. In view of the aforesaid I am of the opinion that in the light of the law laid down by the house of lords in the aforesaid judgment the registration certificate issued by second respondent in favour of the first respondent is erroneous and is not inrespect of a design invented as a new design by the respondent no.1 and thus consequently requires to be cancelled. In the light of the aforesaid I make the present petition absolute in terms of prayer clause (a). and (b). However there shall be no order as to costs.

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FOR REASONS RECORDED SEPERATLY, THE COURT PASSED THE FOLLOWING ORDER :

1. The present petition has been filed interalia seeking relief that the design registered by the respondent no.1 being design no. 163381 dated 5.7.1991 in class-1 be cancelled and the second respondent should be directed to expunged and or remove the entry of the said registration from the register of designs.

2. In view of the aforesaid I am of the opinion that in the light of the law laid down by the house of lords in the aforesaid judgment the registration certificate issued by second respondent in favour of the first respondent is

erroneous and is not inrespect of a design invented as a new design by the respondent no.1 and thus consequently requires to be cancelled. In the light of the aforesaid I make the present petition absolute in terms of prayer clause (a). and (b). However there shall be no order as to costs.

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